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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/544,573	08/05/2005	Yoshihiro Yoneda	052875	8278

38834 7590 06/09/2009  
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WASHINGTON, DC 20036

EXAMINER
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STEITZ, RACHEL RUNNING

ART UNIT	PAPER NUMBER
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3732

MAIL DATE	DELIVERY MODE
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06/09/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/544,573	<b>Applicant(s)</b> YONEDA ET AL.	
	<b>Examiner</b> RACHEL R. STEITZ	<b>Art Unit</b> 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 14-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to because Figures 9-13 are not of sufficient quality after scanning so that all details in the photographs are reproducible in the printed patent. See MPEP 507F and 37CFR 1.83(b). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 1 states, "at least a side of the adhesive layer to the net member has a thickness more than half of a wire diameter of the net member", however, the parameter of the "wire diameter" has not be defined, therefore it is unclear as to what constitutes a thickness more than half the wire diameter.

5. Claim 9 states, "the adhesive layers is formed to have a thickness to bury more than half a wire diameter of the net member"; however, the parameter of the "wire diameter" has not be defined, therefore it is unclear as to what constitutes a thickness to bury more than half a wire diameter.

6. Claim 10 states, "said adhesive layers is formed to have a thickness equal to, or more than a wire diameter of said net member"; however, the parameter of the "wire diameter" has not be defined, therefore it is unclear as to what constitutes a thickness to bury more than half a wire diameter.

7. Claim 12 states, "said adhesive layers is formed to have the thickness equal to, or more than the diameter of a hair", however, it is well known in the art that hair can have varying thicknesses depending on the color of the hair and the genetics of the person, therefore, applicant has not clearly defined a parameter for the "diameter of a hair" making the scope of the claim indefinite.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-11, 12/1, 12/2, 12/8, 12/9, 13/12/1, 13/12/2, 13/12/8, and 13/12/9 are rejected under 35 U.S.C. 103(a) as being unpatentable over of Maekawa (US 6,170,491) in view of Gold (US Pub 2004/0237987).

Regarding claim 1, Maekawa discloses a double stick adhesive tape for a wig which as a net member (3) as a portion of the wig base (2) comprising two adhesive surface layers (21a,21b) wherein at least a side of the adhesive layer to the net member has a thickness more than half of a diameter of the net member (see Figure 1b; column 2, lines 64-68). Since applicant has not specified the parameters of the wire diameter, one having ordinary skill in the art at the time the invention was made would have been able to modify Maekawa so that the adhesive has a thickness more than half of a diameter of the net member, to be deemed matters of design choice, will within the skill of the ordinary artisan, obtained through routine experimentation in determining optimum results. Maekawa does not disclose at least one surface of the two adhesive surfaces being deglossed. Gold teaches an adhesive surface being deglossed (see Figure 8b; paragraph 52). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify at least one adhesive layer of

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Maekawa by having the surface be deglossed as taught by Gold in order to increase the transpiration of the adhesion.

Regarding claim 2, Maekawa does not disclose the thickness of one side of the adhesive layer to the net member having a thickness range between 50 and 200  $\mu\text{m}$ . However, one having ordinary skill in the art would find the parameters of the thickness of the adhesive layer to be deemed matters of design choice, will within the skill of the ordinary artisan, obtained through routing experimentation in determining optimum results. Further it is well known in the art to make adhesive layers in the order of microns as evidence by Shin (US 2002/0056465 paragraph 38).

Regarding claim 3, Maekawa does not disclose the thickness of one side of the adhesive layer to the net member having a thickness range between 50 and 200  $\mu\text{m}$  and the other side of the adhesive layer having a thickness range between 50 and 150  $\mu\text{m}$ . However, one having ordinary skill in the art would find the parameters of the thickness of the adhesive layers to be deemed matters of design choice, will within the skill of the ordinary artisan, obtained through routing experimentation in determining optimum results. Further it is well known in the art to make adhesive layers in the order of microns as evidence by Shin (US 2002/0056465 paragraph 38).

Regarding claims 4-8, in that the minute concavity and convexity are formed by pressing the adhesive layer with a press having minute saliences, spray-coating granular adhesive, a blasting process, and by a blast process using finely crashed dry ice, it is noted that the patentability of a product does not depend on its method of production, therefore, the combination of Maekawa and Gold meets the limitation since

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the final product consists of minute concavity and convexity. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Regarding claim 9, Maekawa discloses a double stick adhesive tape for a wig which as a net member (3) as a portion of the wig base (2) comprising two adhesive layers (21a,21b) of a double-stick adhesive tape (see Figure 1b; column 2, lines 64-68). A first side of the adhesive layer (21a) is formed to have a thickness to bury more than half of a wire diameter of the net member (3) (column 3, lines 48-55). Since applicant has not specified the parameters of the wire diameter, one having ordinary skill in the art would understand that Maekawa teaches having the adhesive come to the surface of the net member, hence burying more than half of a wire diameter. Maekawa does not disclose a second side of the adhesive layers being deglossed. Gold teaches an adhesive surface being deglossed (see Figure 8b; paragraph 52). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify at least one adhesive layer of Maekawa by having the surface be deglossed as taught by Gold in order to increase the transpiration of the adhesion.

Regarding claim 10, Maekawa discloses one side of the adhesive layers (21a) is formed to have a thickness equal to or more than a wire diameter of the net member (column 3, lines 48-55). Since applicant has not specified the parameters of the wire diameter, one having ordinary skill in the art would understand that Maekawa teaches

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having the adhesive come to the surface of the net member, hence burying a thickness equal to the wire diameter.

Regarding claim 11, Maekawa does not disclose the thickness of one side of the adhesive layers being in the range between 50 and 200  $\mu\text{m}$ . However, one having ordinary skill in the art would find the parameters of the thickness of the adhesive layer to be deemed matters of design choice, will within the skill of the ordinary artisan, obtained through routing experimentation in determining optimum results. Further it is well known in the art to make adhesive layers in the order of microns as evidence by Shin (US 2002/0056465 paragraph 38).

Regarding claims 12/1, 12/2, 12/8, and 12/9, Maekawa does not disclose the other side of the adhesive layer is formed to have the thickness equal to or more than the diameter of a hair, however, applicant has not clearly defined the parameters of the diameter of a hair, therefore, the parameters of the thickness of the adhesive layer is deemed matters of design choice, will within the skill of the ordinary artisan, obtained through routing experimentation in determining optimum results.

Regarding claims 13/12/1, 13/12/2, 13/12/8, and 13/12/9, Maekawa does not disclose the thickness of other side of the adhesive layers being 50  $\mu\text{m}$  or more. However, one having ordinary skill in the art would find the parameters of the thickness of the adhesive layer to be deemed matters of design choice, will within the skill of the ordinary artisan, obtained through routing experimentation in determining optimum results. Further it is well known in the art to make adhesive layers in the order of microns as evidence by Shin (US 2002/0056465 paragraph 38).



***Response to Arguments***

10. Applicant's arguments filed March 10, 2009 have been fully considered but they are not persuasive.

11. In response to applicant's drawings filed March 10, 2009, the drawings do not comply with MPEP 507F since after scanning they are not of sufficient quality so that all details in the photograph are reproducible in the printed patent.

12. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the adhesive layer to the net member for fitting the net member of a wig base) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

13. In response to applicant's argument that Maekawa does not disclose a thickness of the adhesive layer to the net member, Maekawa does disclose the adhesive having a thickness (see Figure 1b).

14. In response to applicant's argument that Maekawa does not disclose the adhesive layer attached to the net member, Maekawa does disclose the adhesive layer attached to the net member (see Figure 2; column 3, lines 47-55).

***Conclusion***

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RACHEL R. STEITZ whose telephone number is (571)272-1917. The examiner can normally be reached on Monday-Friday 7:00 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robyn Doan/  
Primary Examiner, Art Unit 3732

/Rachel Running Steitz/  
Examiner  
Art Unit 3732